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Filing date: **09/06/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177540
Party	Defendant OnPoint Community Credit Union
Correspondence Address	STEPHEN F. COOK BULLIVANT HOUSER BAILEY PC 888 SW 5TH AVE STE 300 PORTLAND, OR 97204-2089 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Stephen F. Cook
Filer's e-mail	steve.cook@bullivant.com
Signature	/Stephen F. Cook/
Date	09/06/2007
Attachments	9-6-07 - Ans to Not of Opp and Counterclaim for Can of Opposer's Reg .pdf ( 5 pages )(146901 bytes )

Registration Subject to Cancellation

Registration No	2977562	Registration date	07/26/2005
Registrant	Margarini, John 9995 Sunset Drive Sutie 208 Miami, FL 33173 UNITED STATES		
Goods/Services Subject to Cancellation	Class 036. First Use: 2003/10/21 , First Use In Commerce: 2003/10/21 Goods/Services: Mortgage lending		

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 78973431  
Filed September 13, 2006  
For the Mark: ONPOINT MORTGAGE in IC 36

Point Mortgage,	)	Opposition No.: 91177540
	)	
Opposer,	)	
	)	
v.	)	<b>ANSWER TO NOTICE OF</b>
	)	<b>OPPOSITION AND COUNTERCLAIM</b>
OnPoint Community Credit Union,	)	<b>FOR CANCELLATION OF</b>
	)	<b>OPPOSER'S REGISTRATION</b>
Applicant.	)	
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Applicant OnPoint Community Credit Union ("Applicant") hereby answers the Notice of Opposition by, and counterclaims against, Opposer Point Mortgage ("Opposer") as follows.<sup>1</sup>

**OPPOSER'S ALLEGATIONS**

1. Applicant denies Opposer would be damaged by the registration of Applicant's mark ONPOINT MORTGAGE as shown in U.S. Trademark Application No. 78/973,413 for "mortgage loan services for credit union members."

2. Applicant denies Opposer is the owner of U.S. Registration No. 2,977,562 for POINT MORTGAGE for "mortgage lending services."

3. Applicant denies Opposer uses POINT MORTGAGE for "mortgage lending services" and, therefore, denies that Opposer has priority of use of that mark. Applicant further denies that the parties' concurrent use of their respective marks will likely cause confusion in the marketplace.

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<sup>1</sup> The paragraphs in this Answer correspond to Opposer's allegations as drafted and numbered by the Board in its August 24, 2007 ruling on Applicant's Motion to Dismiss.

**FIRST AFFIRMATIVE DEFENSE  
(Failure to State a Claim)**

4. Opposer fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE  
(No Standing)**

5. Opposer lacks standing to oppose because, among other reasons, it is not the owner of U.S. Registration No. 2,977,562 for POINT MORTGAGE and it does not use, or allege that it uses, that mark in commerce. Opposer, therefore, will not and cannot be damaged by the registration of Applicant's mark.

**THIRD AFFIRMATIVE DEFENSE  
(Equitable Defenses)**

6. Opposer's opposition is barred by the doctrines of unclean hands and estoppel.

WHEREFORE, Applicant prays for judgment dismissing the opposition with prejudice and allowing Applicant's ONPOINT MORTGAGE mark to be placed on the Principal Register.

**COUNTERCLAIMS**

By these Counterclaims Applicant petitions for cancellation of U.S. Registration No. 2,977,562 for POINT MORTGAGE for all the services recited in that registration.<sup>2</sup> Cancellation is appropriate under Sections 14(1) and 14(3) of the Lanham Act due to fraud in the procurement of the registration and because POINT MORTGAGE is not used as a trademark.

**FIRST COUNTERCLAIM  
(Fraud for failure to use the mark for the services recited)**

7. POINT MORTGAGE has been placed on the Principal Register under Registration No. 2,977,562 for "mortgage lending."

8. The applicant for and owner of that registration, Mr. Johnny Margarini, asserted in application Serial No. 76/534240 (which matured into Registration No. 2,977,562) that he and/or his licensees offer "mortgage lending" to consumers.

9. Neither Mr. Margarini nor any of his licensees has provided or provides

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<sup>2</sup> Counterclaims for the cancellation of a registration relied upon by an Opposer in a Notice of Opposition are proper under 37 CFR § 2.106(b)(2)(ii) and other authorities.

“mortgage lending” to consumers.

10. Neither Mr. Margarini nor any of his licensees are properly licensed by the appropriate governmental agencies to offer “mortgage lending” to consumers.

11. With knowledge of their falsity, Mr. Margarini declared (1) that he and/or his licensees offer “mortgage lending” to consumers and (2) that those services are offered using POINT MORTGAGE as a trademark. By these declarations and other statements of use regarding POINT MORTGAGE, Mr. Margarini has committed fraud in the procurement of the registration for POINT MORTGAGE.

12. Applicant will be damaged by the continued registration of POINT MORTGAGE on the Principal Register.

**SECOND COUNTERCLAIM**  
**(Failure to use POINT MORTGAGE as a trademark)**

13. Applicant realleges all of its previous allegations as if fully set forth herein.

14. Opposer Point Mortgage is a corporation organized under the laws of the State of Florida and is so registered under the trade name “Point Mortgage Corporation.”

15. Opposer Point Mortgage and Mr. Margarini use POINT MORTGAGE in commerce solely as a trade name, sometimes in conjunction with the word “Corporation” and sometimes without. Under no circumstances is POINT MORTGAGE used as a trademark.

16. Trade names are not registerable on the Principal Register unless there is evidence of the trade name also serving as a trademark. Neither Opposer Point Mortgage nor Mr. Margarini have any evidence of POINT MORTGAGE being used as a trademark.

17. Mr. Margarini’s application to register POINT MORTGAGE as a trademark and the maintenance of the registration of that trade name on the Principal Register constitutes fraud and otherwise violates the statutory requirements for registration.

18. Applicant will be damaged by the continued registration of POINT MORTGAGE on the Principal Register.

WHEREFORE, Applicant prays that the Principal Register be rectified to remove Registration No. 2,977,562.

Date: September 6, 2007

Respectfully Submitted,

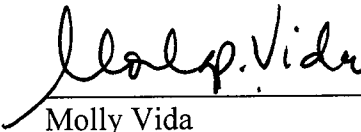
By: /s/ Stephen F. Cook

Stephen F. Cook  
Bullivant Houser Bailey PC  
888 S.W. Fifth Ave., Suite 300  
Portland, OR 97204  
Attorneys for Applicant

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S REGISTRATION has been served on Point Mortgage c/o Johnny Margarini by mailing said copy on September 6, 2007, via First Class Mail, postage prepaid to:

Johnny Margarini  
Point Mortgage  
9999 Sunset Dr., #208  
Miami, FL 33173

  
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Molly Vida